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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

McClurg *et al.*

Appl. No.: 10/725,543

Filed: December 3, 2003

For: **System Having a Rotating Optical System and a Non-Planar Prism that are Used to Obtain Print and Other Hand Characteristic Information**

Confirmation No.: 3189

Art Unit: 2621

Examiner: To be assigned

Atty. Docket: 1823.0820004

**Information Disclosure Statement**

Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

Sir:

Listed on accompanying Form PTO-1449 are documents that may be considered material to the examination of this application, in compliance with the duty of disclosure requirements of 37 C.F.R. §§ 1.56, 1.97 and 1.98.

Applicants have listed publication dates on the attached PTO-1449 based on information presently available to the undersigned. However, the listed publication dates should not be construed as an admission that the information was actually published on the date indicated.

Applicants reserve the right to establish the patentability of the claimed invention over any of the information provided herewith, and/or to prove that this information may not be prior art, and/or to prove that this information may not be enabling for the teachings purportedly offered.

This statement should not be construed as a representation that a search has been made, or that information more material to the examination of the present patent application does not exist. The Examiner is specifically requested not to rely solely on the material submitted herewith.

Applicants have checked the appropriate boxes below.

- ☐ 1. Statement under 37 C.F.R. 1.704(d). Each item of information contained in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart application and this communication was not received by any individual designated in 37 C.F.R. § 1.56(c) more than thirty days prior to the filing of this information disclosure statement.
- ☒ 2. Filing under 37 C.F.R. § 1.97(b). This Information Disclosure Statement is being filed before the mailing date of a first Office Action on the merits. No statement or fee is required.
- ☐ 3. Filing under 37 C.F.R. § 1.97(c). This Information Disclosure Statement is being filed more than three months after the U.S. filing date AND after the mailing date of the first Office Action on the merits, but before the mailing date of a Final Rejection, or Notice of Allowance, or an action that otherwise closes prosecution in the application.
  - ☐ a. Statement under 37 C.F.R. § 1.97(e)(1). I hereby state that each item of information contained in this Information Disclosure Statement was first cited in any communication from a foreign patent office in a counterpart

foreign application not more than three months prior to the filing of this Information Disclosure Statement. 37 C.F.R. § 1.97(e)(1).

☐ b. Statement under 37 C.F.R. § 1.97(e)(2). I hereby state that no item of information in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application and, to my knowledge after making reasonable inquiry, was known to any individual designated in 37 C.F.R. § 1.56(c) more than three months prior to the filing of this Information Disclosure Statement. 37 C.F.R. § 1.97(e)(2).

☐ c. Attached is our PTO-2038 Credit Card Payment Form in the amount of \$\_\_\_\_\_ in payment of the fee under 37 C.F.R. § 1.17(p).

☐ 4. Filing under 37 C.F.R. § 1.97(d) This Information Disclosure Statement is being filed more than three months after the U.S. filing date and after the mailing date of a Final Rejection or Notice of Allowance, but before payment of the Issue Fee. Enclosed find our PTO-2038 Credit Card Payment Form in the amount of \$\_\_\_\_\_ in payment of the fee under 37 C.F.R. § 1.17(p); in addition:

☐ a. Statement under 37 C.F.R. § 1.97(e)(1). I hereby state that each item of information contained in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this Information Disclosure Statement. 37 C.F.R. § 1.97(e)(1).

- ☐ b. Statement under 37 C.F.R. § 1.97(e)(2). I hereby state that no item of information in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application and, to my knowledge after making reasonable inquiry, was known to any individual designated in 37 C.F.R. § 1.56(c) more than three months prior to the filing of this Information Disclosure Statement.
- 37 C.F.R. § 1.97(e)(2).
- ☒ 5. Documents AH1, AB3, AB4, and AD5 were cited in a search report in a counterpart PCT application. A copy of the search report is enclosed as document AN1 for the convenience of the Examiner.
- ☒ 6. A concise explanation of the relevance of the non-English language document AK1 appears below:
- Document AK1 (JP 3-161884) appears to describe a finger image input device.
- An English language abstract of document AK1 is enclosed as document AO1.
- ☒ 7. Copies of documents AJ1, AK1, AN1, and AO1 are submitted herewith.
- ☐ 8. Copies of the documents were cited by or submitted to the Office in an IDS that complies with 37 C.F.R. § 1.98(a)-(c) in Application No. \_\_\_\_\_, filed \_\_\_\_\_, which is relied upon for an earlier filing date under 35 U.S.C. § 120. Thus, copies of these documents are not attached. 37 C.F.R. § 1.98(d).
- ☒ 9. No copies of U.S. patents and patent application publications cited on the attached Form PTO-1449 are submitted in accordance with 1276 OG 55 because this application was filed after June 30, 2003.

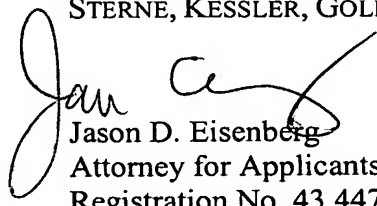
- ☐ 10. It is expected that the examiner will review the prosecution and cited art in the parent application no(s). \_\_\_\_\_ in accordance with MPEP 2001.06(b), and indicate in the next communication from the office that the art cited in the earlier prosecution history has been reviewed in connection with the present application.

It is respectfully requested that the Examiner initial and return a copy of the enclosed PTO-1449, and indicate in the official file wrapper of this patent application that the documents have been considered.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

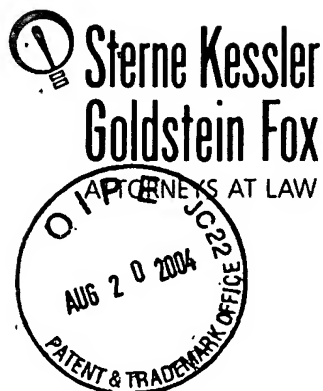
  
Jason D. Eisenberg  
Attorney for Applicants  
Registration No. 43,447

Date: \_\_\_\_\_

8/20/04

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\*Admitted only in Virginia  
\*Practice Limited to  
Federal Agencies

August 20, 2004

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Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

**Art Unit 2621**  
**Mail Stop Amendment**

Re: U.S. Utility Patent Application  
Application No. 10/725,543; Filed: December 3, 2003  
For: **System Having A Rotating Optical System And A Non-Planar Prism  
That Are Used To Obtain Print And Other Hand Characteristic  
Information**  
Inventors: McClurg *et al.*  
Our Ref: 1823.0820004

Sir:

Transmitted herewith for appropriate action are the following documents:

1. Information Disclosure Statement (IDS);
2. Form PTO-1449 (9 sheets) listing the cited documents;
3. Copies of the four (4) cited documents; and
4. One (1) return postcard.

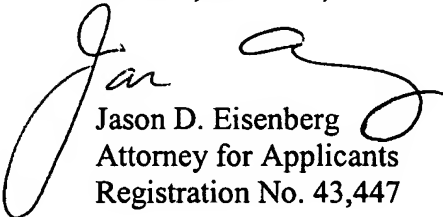
It is respectfully requested that the attached postcard be stamped with the date of filing of these documents, and that it be returned to our courier. In the event that extensions of time are necessary to prevent abandonment of this patent application, then such extensions of time are hereby petitioned.

Commissioner for Patents  
August 20, 2004  
Page 2

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Jason D. Eisenberg  
Attorney for Applicants  
Registration No. 43,447

JDE:amr

300480.1



FORM PTO-1449

# INFORMATION DISCLOSURE STATEMENT

ATTY. DOCKET NO.  
1823.0820004

APPLICATION NO.  
10/725,543

INVENTORS  
McClurg *et al.*

FILING DATE  
December 3, 2003

ART UNIT  
2621

## U.S. PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB-CLASS	FILING DATE
	AA1	2,184,858	12/1939	Goodman			
	AB1	3,054,854	09/1962	Neasham			
	AC1	3,282,152	11/1966	Myer			
	AD1	3,333,502	08/1967	Flanagan			
	AE1	3,511,571	05/1970	Ogle			
	AF1	3,648,240	03/1972	Jacoby <i>et al.</i>			
	AG1	3,716,301	02/1973	Caulfield <i>et al.</i>			
	AH1	3,765,018	10/1973	Heard <i>et al.</i>			
	AI1	3,804,524	04/1974	Jocoy <i>et al.</i>			

## FOREIGN PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB-CLASS	TRANSLATION
	AJ1	WO 96/17480 A2&A3	06/1996	PCT			N/A
	AK1	JP 3-161884	07/1991	JP			No
	AL1						Yes No
	AM1						Yes No

## OTHER (Including Author, Title, Date, Pertinent Pages, etc.)

AN	1	International Search Report from PCT Appl. No. PCT/US03/38644, filed December 5, 2003, 3 pages.
AO	1	English Abstract for Japanese Patent Publication No. 3-161884, published July 7, 1991, 1 page, from <a href="http://v3.espacenet.com/">http://v3.espacenet.com/</a> .
AP	1	
AQ	1	
AR	1	

EXAMINER

DATE CONSIDERED

**EXAMINER:** Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to Applicant.



FORM PTO-1449

INFORMATION DISCLOSURE STATEMENTATTY. DOCKET NO.  
1823.0820004APPLICATION NO.  
10/725,543INVENTORS  
McClurg *et al.*FILING DATE  
December 3, 2003ART UNIT  
2621**U.S. PATENT DOCUMENTS**

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB-CLASS	FILING DATE
	AA2	3,882,462	05/1975	McMahon			
	AB2	4,032,889	06/1977	Nassimbene			
	AC2	4,128,837	12/1978	Page			
	AD2	4,180,306	12/1979	Duhrkoop <i>et al.</i>			
	AE2	4,206,441	06/1980	Kondo			
	AF2	4,206,556	06/1980	Sabo <i>et al.</i>			
	AG2	4,357,597	11/1982	Butler			
	AH2	4,387,365	06/1983	Berry <i>et al.</i>			
	AI2	4,414,684	11/1983	Blonder			

**FOREIGN PATENT DOCUMENTS**

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB-CLASS	TRANSLATION
	AJ2						Yes No
	AK2						Yes No
	AL2						Yes No
	AM2						Yes No

**OTHER (Including Author, Title, Date, Pertinent Pages, etc.)**

	AN	2	
	AO	2	
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	AQ	2	
	AR	2	

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2621**U.S. PATENT DOCUMENTS**

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB-CLASS	FILING DATE
	AA3	4,467,545	08/1984	Shaw, Jr.			
	AB3	4,578,793	03/1986	Kanee <i>et al.</i>			
	AC3	4,688,092	08/1987	Kamel <i>et al.</i>			
	AD3	4,701,960	10/1987	Scott			
	AE3	4,720,869	01/1988	Wadia			
	AF3	4,736,203	04/1988	Sidlauskas			
	AG3	4,736,436	04/1988	Yasukawa <i>et al.</i>			
	AH3	4,751,660	06/1988	Hedley			
	AI3	4,751,759	06/1988	Zoell			

**FOREIGN PATENT DOCUMENTS**

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB-CLASS	TRANSLATION
	AJ3						Yes No
	AK3						Yes No
	AL3						Yes No
	AM3						Yes No

**OTHER (Including Author, Title, Date, Pertinent Pages, etc.)**

	AN	3	
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December 3, 2003ART UNIT  
2621**U.S. PATENT DOCUMENTS**

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB-CLASS	FILING DATE
	AA4	4,774,516	09/1988	Henri <i>et al.</i>			
	AB4	4,790,025	12/1988	Inoue <i>et al.</i>			
	AC4	4,805,117	02/1989	Fiore <i>et al.</i>			
	AD4	4,821,118	04/1989	Lafreniere			
	AE4	5,140,469	08/1992	Lamarre <i>et al.</i>			
	AF4	5,225,924	07/1993	Ogawa <i>et al.</i>			
	AG4	5,249,370	10/1993	Stanger <i>et al.</i>			
	AH4	5,307,264	04/1994	Waggener <i>et al.</i>			
	AI4	5,309,274	05/1994	Akanabe			

**FOREIGN PATENT DOCUMENTS**

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB-CLASS	TRANSLATION
	AJ4						Yes No
	AK4						Yes No
	AL4						Yes No
	AM4						Yes No

**OTHER (Including Author, Title, Date, Pertinent Pages, etc.)**

	AN	4	
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	AA5	5,313,306	05/1994	Kuban <i>et al.</i>			
	AB5	5,367,399	11/1994	Kramer			
	AC5	5,377,002	12/1994	Malin <i>et al.</i>			
	AD5	5,440,428	08/1995	Hegg <i>et al.</i>			
	AE5	5,452,135	09/1995	Maki <i>et al.</i>			
	AF5	5,469,289	11/1995	Iwao <i>et al.</i>			
	AG5	5,526,436	06/1996	Sekiya			
	AH5	5,528,355	06/1996	Maase <i>et al.</i>			
	AI5	5,588,097	12/1996	Ono <i>et al.</i>			

## FOREIGN PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB-CLASS	TRANSLATION
	AJ5						Yes No
	AK5						Yes No
	AL5						Yes No
	AM5						Yes No

## OTHER (Including Author, Title, Date, Pertinent Pages, etc.)

	AN	5	
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	AP	5	
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	AR	5	

EXAMINER

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EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB-CLASS	FILING DATE
	AA6	5,610,751	03/1997	Sweeney <i>et al.</i>			
	AB6	5,638,461	06/1997	Fridge			
	AC6	5,650,842	07/1997	Maase <i>et al.</i>			
	AD6	5,677,782	10/1997	Peng			
	AE6	5,699,186	12/1997	Richard			
	AF6	5,777,751	07/1998	Ward			
	AG6	5,796,426	08/1998	Gullichsen <i>et al.</i>			
	AH6	5,798,923	08/1998	Laskowski			
	AI6	5,937,102	08/1999	Jin			

**FOREIGN PATENT DOCUMENTS**

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB-CLASS	TRANSLATION
	AJ6						Yes No
	AK6						Yes No
	AL6						Yes No
	AM6						Yes No

**OTHER (Including Author, Title, Date, Pertinent Pages, etc.)**

	AN	6	
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2621**U.S. PATENT DOCUMENTS**

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB-CLASS	FILING DATE
	AA7	6,038,332	03/2000	Fishbine <i>et al.</i>			
	AB7	6,041,134	03/2000	Merjanian			
	AC7	6,046,867	04/2000	Rana			
	AD7	6,175,407 B1	01/2001	Sartor			
	AE7	6,198,429 B1	03/2001	Fujikawa <i>et al.</i>			
	AF7	6,243,488 B1	06/2001	Penna			
	AG7	6,341,028 B1	01/2002	Bahuguna <i>et al.</i>			
	AH7	6,394,356 B1	05/2002	Zagami			
	AI7	6,411,441 B1	06/2002	Videen			

**FOREIGN PATENT DOCUMENTS**

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB-CLASS	TRANSLATION
	AJ7						Yes No
	AK7						Yes No
	AL7						Yes No
	AM7						Yes No

**OTHER (Including Author, Title, Date, Pertinent Pages, etc.)**

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2621**U.S. PATENT DOCUMENTS**

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB-CLASS	FILING DATE
	AA8	6,415,064 B1	07/2002	Oh			
	AB8	6,459,451 B2	10/2002	Driscoll, Jr. <i>et al.</i>			
	AC8	6,466,686 B2	10/2002	Senior			
	AD8	6,496,608 B1	12/2002	Chui			
	AE8	6,616,065 B2	09/2003	Martin			
	AF8	2002/0049714 A1	04/2002	Yamazaki <i>et al.</i>			
	AG8	2002/0141620 A1	10/2002	Monden			
	AH8	2003/0012417 A1	01/2003	Hamid			
	AI8	2003/0099022 A1	05/2003	Karin <i>et al.</i>			

**FOREIGN PATENT DOCUMENTS**

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB-CLASS	TRANSLATION
	AJ8						Yes No
	AK8						Yes No
	AL8						Yes No
	AM8						Yes No

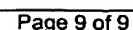
**OTHER (Including Author, Title, Date, Pertinent Pages, etc.)**

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	AO	8	
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ART UNIT 2621
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## U.S. PATENT DOCUMENTS

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